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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Attorney Docket No.: **UK9-99-004**

In re Application of:

**KNOX ET AL.**

Serial No.: **09/477,389**

Filed: **4 JANUARY 2000**

For: **WIRELESS CONNECTION FOR PORTABLE SYSTEMS AND NETWORK ADAPTERS USING WAKE-UP REQUESTS**

Examiner: **LIN, K.**

Art Unit: **2154**

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1 of 3

**APPEAL BRIEF**

MS Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Brief is submitted in triplicate in support of the Appeal in the above-identified application.

**CERTIFICATE OF MAILING**
**37 CFR 1.8(a)**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First-Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date below.

6-11-03
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Kathy Schoen
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## REAL PARTY IN INTEREST

The present application is assigned to International Business Machines Corporation, the real party of interest.

## RELATED APPEALS AND INTERFERENCES

No related appeal is presently pending.

## STATUS OF THE CLAIMS

Claims 1-4 stand finally rejected by the Examiner as noted in the Final Office Action dated April 3, 2003 and the Advisory Action dated April 30, 2003.

## STATUS OF AMENDMENTS

No amendment was submitted subsequent to the Office Action dated November 20, 2002.

## SUMMARY OF THE INVENTION

A portable computer typically has four power management states: a normal operating state, a standby state, a suspend state, and an off state. The normal operating state of a portable computer is virtually identical to the normal operating state of a conventional desktop computer. The standby state consumes less power than the normal operating state; however, most applications are left idle during the standby state. In the suspend state, the portable computer consumes an extremely small amount of power. In the off state, the power supply ceases providing regulated power to the portable computer. The off state is virtually identical to the off state of a conventional desktop computer.

Computer theft has been becoming a widespread problem, particularly for portable computers because they can be easily removed from buildings, cars, etc. One of the major concerns related to a stolen portable computer is that the person who has the possession of the stolen portable computer is able to freely obtain information from the portable computer. Even though password protection is sometimes added to a portable computer, but such password

protection can easily be overcome by an experienced computer hacker. Consequently, it would be desirable to provide an improved security measure for portable computers.

In accordance with a preferred embodiment of the present invention, a data processing network includes a server computer system **20** and a portable client computer system **30**, as shown in Figure **2**. Portable client computer system **30** is capable of wirelessly communicating with server computer system **20** via a wireless link **50**, as depicted in Figure **2**. Connected to server computer system **20**, a control means can issue a wake-up request to portable client computer system **30** via wireless link **50** to switch portable client computer system **30** from a suspend state or an off state to a normal operating state. In addition, the control means can also issues a request to portable client computer system **30** via wireless link **50** to disable portable client computer system **30**. In response to the above-mentioned request to disable portable client computer system **30**, a network adapter **137**, which is connected to portable client computer system **30**, disables portable client computer system **30** from further operations. As such, information cannot be obtained from portable client computer system **30** in case portable client computer system **30** is in the possession of an unauthorized user.

## ISSUE

Is the Examiner's rejection of Claims 1 and 4 under 35 U.S.C. § 103(a) as being unpatentable over *Jackson et al.* (US 6,052,779) well-founded?

## GROUPING OF THE CLAIMS

For purposes of this Appeal, Claims 1-4 stand or fall together as a single group.

## ARGUMENT

The Examiner's rejections of Claims 1 and 4 are not well-founded and should be reversed.

I. *Jackson* does not teach or suggest the claimed control means

Claim 1 recites "a control means ... for issuing a request to said portable client computer system via said wireless connection to disable said portable client computer system" (lines 8-9)

and "a network adapter ... for disabling said portable client computer system from further operations in response to said request" (lines 10-11).

On pages 2-3 of the Final Office Action, the Examiner asserts that the claimed control means is disclosed by *Jackson* in col. 2, lines 3-12, col. 4, lines 28-37, 58-65, col. 5, lines 2-27, 38-42 and col. 8, lines 22-31, and that the claimed network adapter is disclosed by *Jackson* in col. 2, lines 28-37 and col. 5, lines 2-27. In essence, all the above-cited passages in *Jackson* are related to wake-on LAN and wake-up scheduling technique, which are not related to "issuing a request to said portable client computer system via said satellite link to disable said portable client computer system," as claimed. For example, col. 2, lines 28-37 of *Jackson* states:

> The controlling system is preferably operable to automatically calculate the wake-up schedule based on a target start time and a typical boot time for each client system.
>
> In one preferred arrangement, the controlling system is further operable to detect the successful completion of the boot process for each client and to dynamically alter the wake-up schedule for the client systems remaining to be woken up. Thus if a client completes earlier than expected then the controlling system can consider whether the wake-up schedule can be brought forward for the remaining clients.

Hence, it is clear that none of the first group of cited passages (*i.e.*, col. 2, lines 3-12, col. 4, lines 28-37, 58-65, col. 5, lines 2-27, 38-42 and col. 8, lines 22-31) is related to "a network adapter ... for disabling said portable client computer system from further operations in response to said request," as claimed.

As another example, col. 5, lines 2-27 of *Jackson* states:

> Once the POST routines are complete, the system BIOS causes the client to invoke RPL code stored in ROM on the client's network adapter card. This RPL code, executing on the client system processor causes the client to broadcast RPL requests onto the network (step 220), the RPL requests specifying at least the network address of the client, which address is burned into adapter ROM during manufacture. The RPL code additionally opens a Service Access Point (SAP) at the client through which responses are received during the boot process.
>
> The RPL request is then received by the one or more servers (which may be the same as the server issuing the wake-up frame) executing a process which compares the network address of the client against a locally stored list of known clients. If the comparison indicates that the server is

> responsible, it responds (step 230) by sending a reply to the client directly using the client address specified in the RPL request. This reply specifies the network address of the responding server. The client then requests (step 240) the software image from the server which responds (step 250) by sending the software image to the client for temporary storage in volatile memory. The client then executes the software image which may be either an operating system and application software for the client's intended function, or a bootstrap program that causes the client to load its operating system from its local storage.

Similarly, it is clear that none of the second group of the cited passages (*i.e.*, col. 2, lines 28-37 and col. 5, lines 2-27) is related to "a network adapter ... for disabling said portable client computer system from further operations in response to said request," as claimed. Because the claimed control means and network adaptor are not taught or suggested by *Jackson*, the § 103 rejection is improper.

II. *Jackson* does not teach or suggest the claimed network adapter that is capable of disabling a portable computer from further operations

On page 2 of the Advisory Action, the Examiner asserts that "the features upon which applicant relies (i.e., satellite link) are not recited in the rejected claim(s)." As mentioned previously, Claim 1 recites "a control means ... for issuing a request to said portable client computer system via said wireless connection to disable said portable client computer system" (emphasis added) (lines 8-9) and "a network adapter ... for disabling said portable client computer system from further operations in response to said request" (lines 10-11). The wireless connection is further defined in Claim 2 as a satellite data link.

On page 2 of the Advisory Action, the Examiner also asserts that "remotely disabling computer system is well known in the art. Furthermore, Jackson el al taught in the disclosure remote boot includes powering up reboot (col. 1, lines 21-30). One would have been motivated to also enable the system to remotely shut down the client computer in order to save power."

Appellants disagree. First, Appellants content that the claimed request for wirelessly disabling a portable computer system is not well-known in the art; otherwise, the Examiner would have easily provided a reference regarding such. Second, the Examiner might have mistaken

"disabling" a portable computer system with "powering off" a portable computer system. The "disabling" of a portable computer system would render the portable computer system non-useable for the purpose of preventing any non-authorized access to a portable computer system in order to handle the problem of computer theft outlined in page 3, lines 15-25 of the specification. Third, the so-called "remote boot" as explained in col. 1, lines 21-30 of *Jackson* is related to a typical network environment in which multiple client computer systems are connected to one or more server computer systems (col. 1, lines 9-11) via a wired network, and such typical network environment is not wireless, as claimed.

On page 2 of the Advisory Action, the Examiner then asserts that even though the claimed network adapter for disabling a portable client computer system is not disclosed by *Jackson*, but "it would have been obvious to one of ordinary skill in the art at the time of invention was made to also enable power-down in Jackson et al's system to shut down the client computers."

The Examiner further asserts that the method of remotely disabling computer system can be found in *Basu* (US 5,842,011) and *McHann, Jr.* (US 5,983,353). It is noted that *Basu* and *McHann, Jr.* were not cited as references before the Advisory Action dated April 30, 2003. Furthermore, the claimed wireless connection is distinguished over *Basu*'s remote connection that utilizes a wired network. Also, the claimed "disabling [a] ... portable computer system from further operations is distinguished over *McHann*'s low power mode because *McHann*'s computer system can exit the low power mode while the claimed portable computer system is rendered inoperable after it is disabled. Since the claimed invention recites novel features that are not taught or suggested by the cited references, the § 102 rejection is improper.

## CONCLUSION

For the reasons stated above, Appellants believe that the claimed invention clearly is patentably distinct over the cited references and that the rejections under 35 U.S.C. § 103 are not well-founded. Hence, Appellants respectfully urge the Board to reverse the Examiner's rejection.

Please charge the IBM Deposit Account **50-0563** in the amount of $320.00 for submission of a Brief in support of Appeal. No additional fee or extension of time is believed to be required; however, in the event an additional fee or extension of time is required, please charge that fee or extension of time requested to the IBM Deposit Account **50-0563**.

Respectfully submitted,

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## CONCLUSION

For the reasons stated above, Appellants believe that the claimed invention clearly is patentably distinct over the cited references and that the rejections under 35 U.S.C. § 103 are not well-founded. Hence, Appellants respectfully urge the Board to reverse the Examiner's rejection.

Please charge the IBM Deposit Account **50-0563** in the amount of $320.00 for submission of a Brief in support of Appeal. No additional fee or extension of time is believed to be required; however, in the event an additional fee or extension of time is required, please charge that fee or extension of time requested to the IBM Deposit Account **50-0563**.

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## APPENDIX

1. A data processing network comprising:

a server computer system;

a portable client computer system capable of wirelessly communicating with said server computer system;

a control means, connected to said server computer system, for issuing a wake-up request to said portable client computer system via a wireless connection to switch said portable client computer system to a normal operating state from a low-power or off state, and for issuing a request to said portable client computer system via said wireless connection to disable said portable client computer system; and

a network adapter, connected to said portable client computer system, for disabling said portable client computer system from further operations in response to said request.

2. The data processing network of claim 1, wherein said wireless connection is a satellite data link.

3. The data processing network of claim 1, wherein said wireless connection is a Digital Enhanced Cordless Telecommunications (DECT) link.

4. The data processing network of claim 1, wherein said wake-up request includes a Wake-on-LAN frame.